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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/943,438

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Shirley J. Provinse

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EXAMINER

AKINTOLA, OLABODE

ART UNIT

PAPER NUMBER

3691

NOTIFICATION DATE

DELIVERY MODE

11/13/2008

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 09/943,438	<b>Applicant(s)</b> PROVINSE, SHIRLEY J.	
	<b>Examiner</b> OLABODE AKINTOLA	<b>Art Unit</b> 3691	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 August 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2,5,6,11-16 and 25-41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,5,6,11-16 and 25-41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>8/26/2008</u> .   | 6) <input type="checkbox"/> Other: _____                          |

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## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-2, 5-6, 11-15, 25-41 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Here, the state of the law with respect to statutory subject matter eligibility under §101 is evolving and is presently an issue in several cases under appeal at the Federal Circuit with regard to process claims. As presently understood, based on Supreme Court precedent and recent Federal Circuit decisions, [see *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)] a §101 statutory process must (1) be tied to another statutory class (e.g. such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. If neither of these requirements is met, a method is not a patent eligible process under §101 and should be rejected as being directed to non-statutory subject matter.

For example, a method claim that recites purely mental steps (e.g. can be performed by mental process or human intelligence alone) would not qualify as a statutory process. To qualify as a §101 statutory process, the claim should (1) positively recite another statutory class (e.g. thing or product) to which it is tied (e.g. by identifying the apparatus that accomplishes the method steps)

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or (2) positively recite the subject matter that is being transformed (e.g. by identifying the material that is being changed to a different state).

As per Claims 1-2, 5-6 and 35-40, Examiner asserts that said method steps could be performed by merely mental steps (e.g. can be performed by mental process or human intelligence alone). Here, Applicant does not adequately tie his/her steps to another statutory class to qualify as a §101 statutory process.

Secondly, Examiner notes that Applicant's recitation of a "system" in claims 11-16 is inadequate as it could, reasonably, be broadly interpreted to include a group of people using their mental capacities. These system claims do not have any hardware components.

Lastly, claims 25-34 recite a computer-readable medium having stored thereon a plurality of instructions, however, this is simply a medium having information stored thereon. Since the instructions are not being executed per se, they do not have any functionality. Examiner suggests amending the claim 25 to include in the preamble, "...the plurality of instructions which when executed on a computer performs a method of providing account reconciliation for an account comprising the steps of: matching...."

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35

U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-2, 5, 11-15, 25-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vance et al (USPN 6442526) in view of Zucker et al (USPAP 20050027617).

Re claims 1-2, 5, 11-15, 25-39: Vance teaches a method (and corresponding system and computer readable medium) of providing account reconciliation for an account comprising the steps of: matching a first charge to a first amount of a travel record, wherein a department code (*reference or identifying code or number*) is associated with said travel record, and wherein said travel record includes said first amount and first data; and assigning said first charge to said department code; associating a second charge with said first data of said travel record, and wherein said second charge is associated with a change to said travel record (see figs. 16I and 17 ele. 1700-1750, col. 13, lines 36 through col. 14, lines 65; col. 2, lines 1-3).

Vance does not explicitly teach associating a second charge with said first data of said travel record, wherein said travel record does not include said second charge, and wherein said second

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charge is associated with a change to said travel record; and assigning said second charge to said department code associated with said travel record.

However, Zucker teaches the concept of association a second charge (“return”, “sears” and “-100”, Fig. 13) with a first data of a transaction record, and wherein the second charge is associated with a change in transaction record; and assigning said second charge to said department code associated with said transaction record (paragraph 0092). It would have been obvious to one of ordinary skill in the art at the time of the invention to recognize the advantage of assigning a second charge to the same department code of the first charge for reconciliation purposes. By using the same charge card, the first charge (original charge) and the second charge (associated with the change in travel record) would appear in the charge card statement with the same reference codes (for example "Sears"). With this commonality (“Sears”), the first amount in the travel record and the first and second charge in the charge card record can be easily reconciled whether or not travel record include the second charge which reflects a change in transaction after the first charge.

Claims 6, 16 and 40-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vance in view of Zucker and further in view of Dunn et al (USPN 5134564).

Re claims 6, 16 and 40-41: Vance teaches compiling matches and generating a report from the compilation (fig. 17). Vance does not explicitly teach compiling near matches. Dunn teaches compiling near matches (col. 3, lines 19- 24; col. 3, line 52- col. 32, line 13; col. 20, lines 26-30;

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Fig. 2). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Vance to include this steps as taught by Dunn in order to speed up the account reconciliation process by determining probably matches using matching criteria.

### ***Response to Arguments***

Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to OLABODE AKINTOLA whose telephone number is (571)272-3629. The examiner can normally be reached on M-F 8:30AM -5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on 571-272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

OA

/Hani M. Kazimi/  
Primary Examiner, Art Unit 3691